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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,082	06/27/2003	Robert Edward Wilson	SAS-001	7448
7590	09/08/2004			
Dane C. Butzer 681 Woodduck Ct. Columbus, OH 43215				EXAMINER
				KAVANAUGH, JOHN T
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/609,082	WILSON ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Ted Kavanaugh	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 7-30-03.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-38 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Throughout the original filed disclosure applicant teaches a "sandal" or a "sandal sock" to attachable to a sandal. Now applicant is claiming a "sandal or shoe" and therefore "or shoe" is new matter.

3. Claims 1-15,27-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not clear if the "second covering" is being positively claimed or only functionally claimed and therefore is indefinite.

In claim 9, if the "second covering" is being positively recited in claim 1 then claim 9 is unclear and indefinite because sandal sock comprising the second covering has already been positively defined in claim 1?

Claims 15 and 27 are unclear and indefinite it is not clear how they further limit the claimed "sandal sock".

In claim 28, it would appear applicant intends to positively claim the "covering". However, it is originally functionally cited (i.e. for a covering) and then the language after that would appear to positively claim it. Applicant should amend to clarify what is being claimed.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,5,6,8,9,14-16,20,21,24,26-28,32,37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 2865097 (Vollrath, Jr. et al) in view of Official Notice.

Vollrath teaches an inner sole lining for a sandal having structure as claimed including a first covering (1) having a cotton layer (3) and a padding layer (2), a second covering (the inner sole not show) wherein the first covering is removable, via double face adhesive (4), to the second covering and the second cover is more securable to the sandal. It is well known and conventional in the art for sandal's to comprise of a base and or more straps, thongs, ties or some combination thereof dispose to secure the base to a person's foot. The inner sole (second covering) of Vollrath is not shown but it is conventional in the art to combined inner sole by a permanent means such as adhesive and/or stitching and therefore this would have a stronger bond the double face adhesive with is made to be removable (see col. 2, lines 67-71). Regarding claims 5

and 21, the inner sole lining is inherently capable of being washed inasmuch as it can be removed and washed with water. Regarding claims 14 and 26, the shape of the innersole lining of Vollrath has a shape that would fit a generic shape of a sandal or other type of footwear.

103-rejection (alternative rejection)

It is well known and conventional in the art for sandal's to comprise of a base and one or more straps, thongs, ties or some combination thereof dispose to secure the base to a person's foot. Therefore, it would have been obvious to provide the inner sole lining (sandal sock) of Vollrath to be placed in a conventional type sandal. The inner sole (second covering) of Vollrath is not shown but it is conventional in the art to combined inner sole by a permanent means such as adhesive and/or stitching and therefore this would have a stronger bond the double face adhesive with is made to be removable (see col. 2, lines 67-71). Therefore, it would have been obvious to provide the inner sole lining (sandal sock) of Vollrath with the inner sole permanently attached.

6. Claims 1-3,6,9-12,14,15,16,17,18,21,24,26,27,32-38 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6205685 (Kellerman).

Kellerman teaches a shoe insert having structure as claimed including a first covering (cushioning pads having a bottom layer of hooks), a second covering (insert with top cloth layer of loops) wherein the first covering is removable, via the hook and loop type fastener, to the second covering and the second cover is more securable to the footwear (the second covering (insert) is attached by adhesive which has a stronger

bond than hook and loop type material). Regarding claims 5 and 21, the insert is inherently capable of being washed inasmuch as it can be removed and washed with water. Regarding claims 14 and 26, the shape of the insert of Kellerman has a shape that would fit a generic shape of a sandal or other type of footwear. Regarding claim 12, Kellerman teaches a protective sheet that can be peeled off to expose the adhesive before attaching to the sole of the footwear.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10,11 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vollrath '097 in view of Official Notice.

Vollrath teaches an innersole for a sandal substantially as claimed (see the rejection above) except Vollrath is silent with regard to how the inner sole is attached to the base of the sandal. The examiner takes official notice that it is well known and conventional in the art to secure the inner sole by a permanent means such as adhesive to provide a permanent bond.

9. Claims 2-4,17-19,29-31, 33 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1,16,28,32 and 37 respectively above, and further in view of Greenwalt.

Greenwalt teaches using a hook-and loop type fastener to removably secure the sole unit to the footwear. It would have been obvious to provide the inner sole lining (sock sole) as taught above with a hook and loop type fastener, as taught by Greenwalt, to facilitate detachable securing the unit to the sandal. Greenwalt teaches hook part on one of the fastener and the loop part on the other of the fastener. Moreover, it would be obvious to reverse the hook and loop type arrangement inasmuch as they would work equally as well.

10. Claims 7,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 16, respectively above, and further in view of US 2002/0066209 (Steed et al).

Steed teaches impregnating the top surface of the insert with a deodorant and a medicinal ingredient, see paragraph #7. It would have been obvious to provide the insert or lining as taught above with the top surface having a deodorant and/or a medication, as taught by Steed, to enhance foot hygiene.

11. Claims 13 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 9 and 16 respectively above, and further in view of US 3404469 (Prenovitz).

Prenovitz teaches a sandal having an insert (1) with a slit (1') to secure the insert around the toe strap of the sandal. It would have been obvious to provide the inner sole

lining (sandal sock) of the sandal as taught above with a slit, as taught by Prenovitz, to facilitate attaching the inner sole around a toe strap of the sandal.

**12. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:**

**-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”**

**--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”**

**-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.**

13. Information about your application can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov). Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Telephone inquiries regarding other general questions, by persons entitled to the information, “should be directed to the group clerical personnel and not to the examiners” M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306

Art Unit: 3728

**(FORMAL FAXES ONLY).** Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached from 6AM - 4PM.



Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK

February 10, 2004